



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,289	03/27/2001	Hiroshi Hatakama	1095.1179	7696

21171 7590 03/31/2004
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

HARLE, JENNIFER I

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,289

Applicant(s)

HATAKAMA ET AL.

Examiner

Jennifer I. Harle

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Claims 1-21 are pending. Claims 1-21 are rejected.

Claim Rejections - 35 USC § 112

Although Applicant(s) use “means for” in the claim(s) (e.g. claim 20 and 21), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th Paragraph*.¹

Failure by Applicant(s) to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

¹ Federal Register Vol. 65, No 120, June 21, 2000.

Claim 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (6,405,175 B1).

Ng discloses a product information acquiring registering method for making registration of information about products by users who operate terminals via the Internet by entering product information via the terminal of the user by means of access to a Web page for making registration of product information (Figs. 2-9; cols. 3-4, lines 23-8, cols. 5-11); and

Sending the given items of product information to a server that manages a database for storing the product information (Figs. 2-9; cols. 3-4, lines 23-8, col. 5, lines 10-20, cols. 5-11).

Ng additionally discloses that the user receives a reward based upon the number of times the product is viewed and hyperlink is followed (Figs. 2-9; cols. 3-4, lines 23-8, col. 4, lines 57-67, cols. 5-11).

Ng further discloses that the Internet is increasingly being used for purchases with virtual stores replacing the so-called bricks-and mortar stores as they can serve customers in many different cities/states without the costly local stores and that moreover, a shopper uses his browser for comparison purposes (cols. 1-2). Moreover, Ng discloses that online reviews are provided linking shoppers to compare products as well as prices and that ordinary people have posted reviews and comments about products through newsgroups and on product web sites but that they are often difficult to find and navigate because the product reviews are not linked to the specific goods, that there is a significant cost and time factor to accumulate product reviews and build a database of products and prices, while use of consumers utilizing a reward system to build and correct such a database based upon the utility of the information, its usage and relevancy, i.e. how up-to-date and reliable. However, Ng does not disclose that the product

Art Unit: 3627

information acquiring method can be used with combination information. The examiner takes Official Notice that the individuals also recommend combination product information through the same channel on the Internet and registration of that information would provide the same benefits as set forth for the individual products in Ng, see, e.g., Newgroups ott.forsale.other date March 5, 1997 describing selling a headpiece and wedding dress together because of the nice effect and Kevin G. Barkes, A Matter of Ethics, DEC Professional, Vol. 14, No. 4, April 1995, pg. 44(2) describing a personal recommendation of two pieces of software that he purchased and his relationship with the companies. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized combination product information in the product information registering method of Ng because consumers are often shopping for related products, merchants utilize this information to upsell and cross-sell to increase profits and decrease inventories and thereby increase profitability, and merchants/manufacturers utilize this information to market products to consumers, i.e. bundling, in order to generate increased revenue streams and remain competitive.

Claims 1-10, 11-15, 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobi, et al. (2001/00291 A1) in view of Ng (6,405,175 B1).

As per claims 1, 6-7, and 10 Jacobi discloses a product information supply method for supplying a terminal of a user who desires to purchase a product via a network with information about a related product that could be bought together with said product (Figs. 1, 2, 5, 7; Abstract; [0003]), said method steps comprising:

Receiving combination information about combinations of products (Figs. 1-7; Abstract; [0003]-[0019]);

Art Unit: 3627

Searching the database in response to inquiring information about the combination information from the terminal of the user to supply the terminal of the user with corresponding combination information extracted from the database on the basis of the inquiring information (Figs. 1-7; Abstract [0003]-[0019]).

Jacobi discloses that the combination information utilized does not require the recommendations/ratings of other users, it is based on the collective interests of the community of users ([0011]).

Ng discloses receiving information about products from a terminal of a person who is rating the product and providing feedback, i.e. bought the product and liked or didn't like it and making registration of the product information with a database so that the product information can be accumulated and a reward can be sent to the registering person based on following a hyperlink to obtain more information via the Internet (Figs. 1-7; ; cols. 3-4, lines 23-8, col. 4, lines 57-67, cols. 5-11).

Ng further discloses that the Internet is increasingly being used for purchases with virtual stores replacing the so-called bricks-and mortar stores as they can serve customers in many different cities/states without the costly local stores and that moreover, a shopper uses his browser for comparison purposes (cols. 1-2). Moreover, Ng discloses that online reviews are provided linking shoppers to compare products as well as prices and that ordinary people have posted reviews and comments about products through newsgroups and on product web sites but that they are often difficult to find and navigate because the product reviews are not linked to the specific goods, that there is a significant cost and time factor to accumulate product reviews and build a database of products and prices, while use of consumers utilizing a reward system to

Art Unit: 3627

build and correct such a database based upon the utility of the information, its usage and relevancy, i.e. how up-to-date and reliable. However, Ng does not disclose that the product information acquiring method can be used with combination information. The examiner takes Official Notice that the individuals also recommend combination product information through the same channel on the Internet and registration of that information would provide the same benefits as set forth for the individual products in Ng, see, e.g., Newgroups ott.forsale.other date March 5, 1997 describing selling a headpiece and wedding dress together because of the nice effect and Kevin G. Barkes, A Matter of Ethics, DEC Professional, Vol. 14, No. 4, April 1995, pg. 44(2) describing a personal recommendation of two pieces of software that he purchased and his relationship with the companies. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized combination product information in the product information registering method of Ng because consumers are often shopping for related products, merchants utilize this information to upsell and cross-sell to increase profits and decrease inventories and thereby increase profitability, and merchants/manufacturers utilize this information to market products to consumers, i.e. bundling, in order to generate increased revenue streams and remain competitive. Moreover, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the database building mechanism as taught in Ng in Jacobi for the explicit reasons taught in Ng, i.e. the costs savings and time savings.

As per claim 2, Jacobi teaches that the inquiry information is a choice signal that indicates a product chosen at the terminal of the user in order to specify a candidate for purchase or place a buy order (Abstract – computer-implement service recommends items based on item

Art Unit: 3627

previously selected by the user, such as item previously purchased or placed in an electronic shopping cart).

As per claims 3-4, Jacobi teaches that the inquiry information is sent from the terminal of the user via an online shop that sells the products ([0030]-[0052] – amazon.com web site).

As per claim 5, neither Jacobi nor Ng explicitly disclose storing the number of times a purchase of the related products have made on the basis of the corresponding combination information supplied to the terminal of the user. However, Jacobi discloses storing the number of times a purchase of the related products have been made [0036] and Ng teaches storing information about the number of times reference has been made to the Web page by the product information and by extrapolation the combination information, as set forth above (cols. 5-11). It would have been obvious to one of ordinary skill in the art at the time of the invention to have stored the number of time a purchase of the related products were made based on the combination information supplied to the terminal of the user because one would have wanted to ensure that the database was functioning properly and the recommendations were being correctly targeted so that the cross-selling and upselling were profitable.

As per claim 8, neither Jacobi nor Ng explicitly disclose determining priority of supply a user with the combination information on the basis of the number of time a purchase of the related products have been made on the basis of the combination information, or based on the number of times reference has been made to the Web page by the corresponding combination information. However, the rewards in Ng are explicitly tied to the number of times reference has been made to the Web page. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have determined priority of supplying the user based on the

Art Unit: 3627

number of times reference has been made to the Web page as taught in Ng in the method of Jacobi because if people were not receiving their rewards, their would be no incentive to create and update the combination database.

As per claim 9, Ng discloses providing rewards, i.e. referral fees from the suppliers to the managers of database based on the number of times a purchase of the related products have been made on the basis of the number of times reference has been made to the Web page by the product information or the user actually buys the product (cols. 13-15).² It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized rewards to managers of the database as taught in Ng in the method of Jacobi because collecting, gathering, storing and providing the information costs money and the revenue would have to be returned to the manager in some form and rewards are one mechanism for providing that revenue that are outcome based and ensure the satisfaction of the suppliers/sellers and provide incentives to the managers of the database.

As per claim 11, Ng discloses that rewards can be based upon product sales and that the web site can also directly handle purchase transactions, rather than simply refer users to the supplier's web site and that the web site may rely on users to verify and refresh data and to verify that the product was purchased, i.e. comment after a predetermined period lapses (cols. 5-13).³ It would have been obvious to one of ordinary skill in the art at the time of the invention to confirm that the product was purchased pursuant to a user recommendation as taught in Ng and to verify that registration, i.e. comment as also taught in Ng for a reward after a predetermined period lapses to the method of Jacobi because rewards cost the supplier/manager money and

² The same analysis applies to the combination information previously set forth in claim 1 for the 103(a) rejection.

implementation of checks and balances streamlines the system and because verification enhances the amount of information collected adding more information to the collaborative filtering mechanism.

As per claim 13, Ng discloses that the web site can be marketed to the public and/or utilized within a company or organization for purposes such as suggestion and quality improvement programs, i.e. marketing information (cols. 13-14).⁴ It would have been obvious to one of ordinary skill in the art at the time of the invention to have produced marketing information as taught in Ng in the method of Jacobi because it provides an additional revenue stream for the company/web site and increases profits, making investors more satisfied.

Claims 13-17 are rejected for the same reasons as claims 1-12. The claims are both drawn to a product information acquiring method, receiving combination information/sending inquiring information about combination information and searching to supply the terminal/outputting the information.

The computer readable recording medium claims 20 and 21 are rejected for the same reasons as claim 1-17.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chislenko, et al. (6,092,049) discloses a method and apparatus for efficiently recommending items using collaborative filtering and feature-guided automated collaborative filtering

³ The same analysis applies to the combination information previously set forth in claim 1 for the 103(a) rejection.

Hosken (6438,579 B1) discloses an automated content and collaoration-based system and methos for determining and providing content recommendations.

Ariyoshi (6408288 B1) discloses an information filtering method and device, and storage medium storing information filtering program.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"⁵ the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁶ the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.⁷ By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the

⁴ Id.

⁵ Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

⁶ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

⁷ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

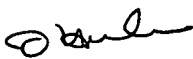
Art Unit: 3627

Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Ione Harle
March 21, 2004